

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 09/680,479

**REMARKS**

Claims 1 and 3-32 are all the claims pending in the application. Claims 1 and 3-32 presently stand rejected.

Claims 1 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dozier et al. (U.S. Patent No. 5,870,552) in view of Katz et al. (U.S. Patent No. 6,496,872).

Claims 3-9 and 11-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dozier et al. in view of Katz et al. and further in view of Pepe et al. (U.S. Patent No. 5,742,905).

For the reasons that follow, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

***Argument***

In responses to previous Office Actions, for example, in the Request for Reconsideration filed August 12, 2003 and the Amendment entered with the RCE filed April 14, 2004, Applicant provided a discussion of the claimed invention as well as a discussion of the prior art references to Dozier et al. and Pepe et al., these discussions are hereby referenced.

The latest grounds of rejection assert that Dozier et al. teaches all of the recited features of independent claims 1 and 10 except for the feature that the processed help content automatically controls various functions of the portable terminal to enable a user of the portable terminal to more easily utilize the text content, a feature recited in all claims, 1 and 3-32. For this feature the grounds of rejection rely on the disclosure of Katz et al. and assert that it would have obvious to combine the independent features of Dozier et al. and Katz et al. “to enable the user to speed up the process by concentrating on the accomplishment of goals, rather than focus upon how to use a computer (col. 2, lines 52-54).”

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Applicant respectfully submits that the grounds of rejection fail to set forth a *prima facie* case of obviousness since it has not been adequately explained why a skilled artisan would have been motivated to combine the prior art references in the manner proposed by the Examiner and that, further, even if the references were combined as proposed, the result would not include all the features of the claimed invention.

Initially, it would not have been obvious for one having ordinary skill in the art to even consult the teachings of the asserted prior art references, let alone combine the “triggering events” disclosed in Katz et al. with the “NaviLinks” system disclosed in Dozier et al. Specifically, Applicant submits, as discussed in the prior responses, the anchor items of the Dozier et al. “NaviLinks” system are completely different than, and entirely unrelated to, the claimed help contents. Specifically, “[a]n ‘anchor’ item [as disclosed in Dozier et al.] is an item of content within a source document encoded as a hypermedia link; users ‘click’ on anchor items to bring up linked target documents.” (Col. 14, lines 30-33). The anchor items of Dozier et al. are for directing a user to additional text content available for certain identified items within a hypermedia document. The anchor items are clearly not the same as the claimed “help content [which] includes specific information regarding how to retrieve or use the text content” and which automatically control hardware functions on the portable device.

Furthermore, the “triggering events” disclosed in Katz et el. are events that are “programmatically detected and used to initiate the performance of an automated task.” (Col. 5, lines 56-58). The concept of the triggering events disclosed in Katz et al. has no relevance or value with respect to the “anchor items”, or any other feature, of Dozier et al. Thus, presented with the issues addressed in the present application and given the context of the prior art

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disclosures, a skilled artisan would not have been motivated to even consult the disclosures of Dozier et al. and Katz et al., nor would there have been any motivation to combine the independent disclosures.

Considered in their entirety, the references asserted by the Examiner do not lead one of ordinary skill in the art to the invention claimed. The references, alone or in combination, do not make obvious the claimed invention. There is no teaching or suggestion whereby a person of ordinary skill would have been led to select the particular respective features of Dozier et al and Katz et al. and combine them. It is well settled that “to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Additionally, with respect to the reasoning provided by the Examiner as to why a skilled artisan *would* have been motivated to make the combination discussed above, the Examiner fails to explain any connection between the asserted “triggering events” of Katz et al. and the “anchor items” in Dozier et al. That is, the Examiner seems to be saying that because, as disclosed in Katz et al., a user can “speed up the process by concentrating on the accomplishment of goals, rather than focusing upon how to use a computer”, some function in Dozier et al. would have been obvious. However, the Examiner has failed to mention what function of Dozier et al. would have been rendered obvious as a result. For the proposed combination to make any sense at all with respect to the claims, the “triggering event” in Katz et al. would have to be imparted somehow on the “anchor item” concept of Dozier et al. This is so because it is the “anchor

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items” in Dozier et al. that the Examiner asserts is akin to the “help content” in the claims, and it is the help content in the claims that is the subject of the automatic control function. There simply is no connection between the “triggering events” in Katz et al. and the “anchor items” in Dozier et al. As disclosed in Katz et al., a “triggering event” is merely an event that can be detected by software, such as a certain sequence of keys being typed on a computer keyboard, to initiate some function. An “anchor item” in the “NaviLinks” system of Dozier et al. is a hypertext link to another document related to a document in which a user is working. There is simply no meaningful way disclosed anywhere in the prior art that the “triggering events” in Katz et al. can be combined with the “anchor items” of Dozier et al.

Accordingly, since no connection has been, or can be, drawn between the “triggering events” in Katz et al. and the “anchor items” in Dozier et al., even if a skilled artisan were to consult the two entirely unrelated prior art references to address the issues addressed in the claims of the present application, which are even further unrelated to the prior art references than the references are to each other, that same artisan would not have been motivated to even attempt to combine the independent features of the two references to address the issue at hand.

For the above reasons, a *prima facie* case of obviousness has not been set forth and the §103 rejection of claims 1 and 3-32 should be withdrawn.

Moreover, assuming *arguendo* that one of ordinary skill in the art were motivated to combine the independent teachings of Dozier et al and Katz et al., the result would not meet all the requirements of the claims. For example, the independent claims each require that the help content be processed and automatically control various *hardware* functions of the device. As disclosed, for example, on pages 12-14 of the specification, the processed help content

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automatically controls the portable device such that one or more of the following hardware functions is activated: certain keys either vibrate and/or are illuminated, certain keys become activated or inactivated, the display is controlled to display static or animated images and a speaker produces an audible sound including instructions, etc.

No hardware functionality is automatically controlled in either Katz et al. or Dozier et al. in response to processed help content. Accordingly, for this additional reason, independent claims 1 and 10, and all claims dependent thereon, are patentable over the proposed combination of Katz et al. and Dozier et al.

In regard to the prior art reference Pepe et al., the Examiner asserts that Pepe et al. “clearly teaches the judging means for judging whether a message belongs to text content or help content”. Again, the Examiner is clearly engaging in selective picking and choosing of an entirely unrelated feature disclosed in an unrelated reference in an attempt to support his obvious argument. Indeed, Pepe et al. discloses a subscriber profile segment that “provides a subscriber’s preferred media for messages delivery and notification.” (Col. 14, lines 66-67). However, the profile segment disclosed in Pepe et al. has absolutely no relevance to either of the other prior art references, Dozier et al. and Katz et al.

The Examiner asserts, on page 5 of the Office Action, that “it would have been obvious at the time of the invention that a person of ordinary skill in the art would add this highly desirable feature of Pepe’s communication system in the modified Dozier so that the information can be divided independently and uniquely.” The Examiner, however, provides no basis whatsoever in support of this assertion. That is, the Examiner cites “col. 14, lines 54-56” in support of the assertion, but the cited passage merely states that “each segment is assigned a unique numeric

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identifier". It is simply not explained why, or even how, the profile segment of Pepe et al. would be combined with the hypertext "anchor items" in the NaviLinks system of Dozier et al.

Therefore, because no supportable basis has been provided as to why a skilled artisan would have been motivated to combine the teachings of Pepe et al. with the teachings of either Dozier et al. or Katz et al., the §103 rejection against claims 3-9 and 11-32 should be withdrawn.

*Conclusion*

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1 and 3-31, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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